



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,131	05/17/1999	ERAN STEINBERG	4473-27	3485

7590 03/14/2002

DAVID H. JAFFER  
PILLSBURY WINTHROP LLP  
2550 HANOVER STREET  
PAL ALTO, CA 94304-1115

EXAMINER

NGUYEN, LUONG TRUNG

ART UNIT	PAPER NUMBER
----------	--------------

2612

DATE MAILED: 03/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/313,131

Applicant(s)  
Steinberg

Examiner  
Luong Nguyen

Art Unit  
2612



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 2, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3-6, 11, 17-22, 30, 33-36, 46, 47, and 49 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 11, 17-22, 30, 33-36, 46, 47, and 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

### **DETAILED ACTION**

1. Note that this case has been transferred to Examiner Luong Nguyen, Art Unit 2612.

#### ***Continued Prosecution Application***

2. The request filed on 12/21/2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/313,131 is acceptable and a CPA has been established. An action on the CPA follows.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 3-6, 11, 17-22, 30, 33-36, 46-47, 49 filed on 12/21/2001 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Objections***

4. Claims 46-47, 49 are objected to because of the following informalities:

Claim 46, line 2, "(a) a message center" should be changed to "a message center" because there is no "(b)" followed.

Claim 49, line 2, "from a said transceiver" should be changed to --from said transceiver--.

Claims 47, 49 are objected as being dependent on claim 46.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. Claims 1, 3-6, 11, 17-22, 30, 33-36, 46-47, 49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 1 and 17, for example, in amendment has been added stating that the **“camera does not send or receive data to or from a communications network.”** However, in the original specification, the system is described as a camera which can communicate with a network. See, for example, page 6, lines 17-18 and page 14, lines 21-23. Because of the discrepancy, the addition of this subject matter to the independent claims is not considered as having support in the originally filed specification.

It appears as if this confusion is caused, in part, by semantics. In the claims, a “camera apparatus” is claimed, which is made up of two parts - a “camera” and a “message apparatus.” However, the specification refers only to a “camera.” The applicants needs to make sure that phraseology used throughout the specification and claims is consistent.

In addition, in amendment has been added stating that **“camera can not communicate with said transceiver,”** in claim 33, and **“digital camera is not functional to communicate with said transceiver,”** in claim 46. However, in the original specification, the disclosure is disclosed that transceiver 125 is included in camera 14, see figure 7, specification, page 14, line 11 through page 15, line 5; page 15, line 22 through page 16, line 4. Because of the discrepancy,

the addition of this subject matter to the independent claims is not considered as having support in the originally filed specification.

Claims 3-6, 11 are rejected as being dependent on claim 1.

Claims 18-22, 30 are rejected as being dependent on claim 17.

Claims 34-36 are rejected as being dependent on claim 33.

Claims 47, 49 are rejected as being dependent on claim 46.

6. Claims 1, 3-6, 11, 17-22, 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language used to refer to different types of data in the independent claims is confusing. For example, in claim 1, there is “first digital image data”, “data”, “second digital data” and “second image data.” It is not clear how, if at all, these different recitations of “data” are related. In claim 17, there is “first digital image data”, “data”, “second data” and “first data.” It is not clear how, if at all, these different recitations of “data” are related.

Additionally, there is no clear antecedent basis support for “said second image data” in lines 10-11 of claim 1; “said message center” in lines 13-14 of claims 1; “said image” in line 3 of claim 6; “said first data” in line 15 of claim 17; “said assembly” in line 2 of claim 18 and in lines 1-2 of claim 22, and in lines 1-2 of claim 30.

Claims 3-6, 11 are rejected as being dependent on claim 1.

Claims 18-22, 30 are rejected as being dependent on claim 17.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-6, 11, 17-22, 30 are rejected under 35 USC 103(a) as being unpatentable over Reelee et al. (U.S. 5,893,037) in view of Ilcisin et al. (US 5,880,770).

Regarding Claim 1, Reelee et al. disclose an integrated digital camera apparatus comprising a housing (See Figure 2, column 4, lines 49-51); a camera (camera unit 10, Figure 2, column 4, lines 47-51) built into the housing, the camera for picture taking as with a separate hand held camera (Figure 1), the camera including image capture apparatus for converting a light image to first digital image data (image sensor 44, Figure 3, column 3, lines 15-20) and wherein said camera does not send or receive data to or from a communications network (See Figures 3-5); a message apparatus (cellular phone 28, Figure 2, column 4, lines 47-51) built into the housing with message functioning independent of the camera, the message apparatus including a transceiver apparatus (transmitter/receiver circuit 54, Figures 4-5, column 3, lines 64-67 ) limited to sending

and receiving second digital data through a communication network and wherein said second image data is not sent to or received from said camera (See Figure 4, column 3, line 64 through column 4, line 31); and a code apparatus for selectively receiving messages sent to the transceiver by a message center (see column 5, lines 25-35 and note that a code is present in the form of dialing the appropriate phone number).

Reele et al. do not disclose an automatic signal transmission apparatus for automatically causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera when the transceiver is turned on. However it is well known in the art to operate a videophone system in such a manner, as disclosed in Ilcisin et al. in order to make sure that necessary messages are received by the person initiating the call (See Column 2, Line 49 through Column 3, Line 12 and note that a camera's identification is inherently conveyed in the initiation of a call from the particular apparatus with which the camera is associated). Such a provision for the Reeley et al. device would clearly increase its utility by increasing the kinds of information available to the users of the videophone network. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide in the Reeley et al. device an automatic signal transmission means for automatically causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera when the transceiver is turned on in order to increase the utility of the device by increasing the kinds of information made available to the user.

Regarding Claim 3, Ilcisin et al. disclose a user activated apparatus for causing the

transceiver to transmit a message request signal to the message center conveying an identification of the camera (See Column 2, Lines 49-56 ).

Regarding Claim 4, Reelee et al. disclose all of the limitations except apparatus disabling the automatic signal transmission apparatus when a user does not want to receive messages. However it is well known in the art to operate a videophone system so as to send messages automatically, as disclosed in Ilcisin et al. in order to make sure that necessary messages are received by the person initiating the call (Column 2, Line 49 - Column 3, Lines 12). Such a provision for the Reelee et al. device would clearly increase its utility by increasing the kinds of information made available to the users of the videophone network. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide in the Reelee et al. device an automatic signal transmission apparatus for automatically causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera when the camera is turned on in order to increase the utility of the device by increasing the kinds of information made available to the user. In Ilcisin et al. this feature may be disabled when the user does not want to receive messages (See Column 3, Lines 65-67 and note that longer-time-period messages may not be acceptable).

Regarding Claim 5, Reelee et al. are silent regarding a model number of the camera and therefore do not disclose that the code apparatus includes identification of a model number of the camera. However it is common practice in the art to form a videophone device using a camera that is separately manufactured, such as the AT&T 2500 disclosed in Ilcisin et al. (See Column 4,



Lines 29-31 of Ilcisin et al. and page 25 of AT&T Technical Journal where the camera is said to be separately manufactured by Sony), the camera clearly having a model number given thereto by its manufacturer. In view of the teaching in Ilcisin et al., it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a separately manufactured camera for the Reelee et al. device since it is well known in the art to so form videophone devices. In such an arrangement the code apparatus would clearly include identification of a model number of the camera since in order for there to be proper reception and display of pictures the model number of the camera used in the manufacture of the sending integrated digital camera apparatus must be the same as that of the receiving integrated digital camera apparatus. The ability to receive, process and display meaningful pictures from a sending camera identifies it having the same model as that of the integrated digital camera apparatus for such a specific videophone network.

Regarding Claim 6, Reelee et al. disclose a display apparatus for displaying the messages (display 30, Figure 2, Column 4, lines 15-20) and an apparatus for displaying the image (display 20, Figure 2, Column 5, lines 10-15, Column 6, lines 5-10).

Regarding Claim 11, Ilcisin et al. disclose an interactive message response apparatus for responding to a question received in a message from the message center (Column 7, lines 40-45).

As for claim 17, all the limitations are contained in claim 1, therefore, see Examiner's comments regarding claim 1, except for the feature a message center including apparatus for collecting, preparing and sorting messages to be sent to a transceiver in an assembly including a digital camera which is disclosed in Ilcisin et al. (Column 2, Line 49 through Column 3, Line 33;

Column 8, Lines 13-35) and a first communication apparatus responsive to reception of a message request signal conveying a camera identification for transmitting messages to the transceiver (Ilcisin et al., See Column 2, Lines 49-56 and note that the calling device's camera identification is inherently provided in the initiation of a call from a particular apparatus with which it is associated);

Regarding Claim 18, Ilcisin et al. disclose that the message center includes a capability to send a selected message to a specific assembly based on the code (Column 2, Lines 49-52).

Regarding Claim 19, Ilcisin et al. disclose that the message center further includes a capability to send a message simultaneously to a plurality of assemblies by transmitting a corresponding particular code (Column 8, Lines 13-35).

Regarding Claim 20, Ilcisin et al. disclose that the message center further includes a capability to prioritize messages as part of a single packet of multiple messages (Column 8, Lines 13-35).

Regarding Claim 21, Ilcisin et al. disclose that the assembly further includes means for disabling the automatic signal transmission apparatus (Column 1, Lines 60-61).

Regarding Claim 22, Ilcisin et al. disclose that the assembly further includes a message display apparatus (display 20).

Regarding Claim 30, Ilcisin et al. disclose an interactive message response apparatus for responding to a question received in a message from the message center (Column 7, Lines 40-45).

9. Claims 33-36, 46-47, 49 are rejected under 35 USC 103(a) as being unpatentable over Ilcisin et al. (US 5,880,770) in view of Reelee et al. (U.S. 5,893,037).

Regarding Claim 33, Ilcisin et al. disclose a method of communication comprising preparing a message at a message center for transmission to a transceiver included in a housing containing an independently functional camera (See Figure 1, Column 2, Line 49 - Column 3, Line 25 and Column 8, Lines 13-35 and note in Figure 1 that the camera 22 clearly functions independently of the transceiver since it is used for taking pictures, not for communicating with the message center); transmitting a message request to the message center by the transceiver, the message request containing identification of the camera and transmitting the messages from the message center to the transceiver (See Column 2, Lines 49-56 and note that the camera's identification is inherently provided since the transceiver with which it is associated is sent message information in response to the request); and displaying the message on a display apparatus (Column 8, Lines 17-19).

Ilcisin et al. do not disclose the camera can not communicate with the transceiver. However, Reelee et al. disclose that the operator can detach the cellular phone 28 which includes transmitter/receiver 54 from camera 10 (Column 5, lines 43-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Ilcisin et al. by the teaching of Reelee et al. in order to reduce the size of the device when the user does not want to transmit or receive image captured by the camera.

Regarding Claim 34, Ilcisin et al. disclose preparing multiple messages to be transmitted

and assigning priority values to the messages (Column 2, Line 59 - Column 3, Line 5; Column 8, Lines 13-35).

Regarding Claim 35, Ilcisin et al. disclose that the priority values include a length of time to display each message (Column 2, Lines 59 - Column 3, Line 7).

Regarding Claim 36, Ilcisin et al. disclose that the priority values include an order of display of the messages (Column 8, Lines 13-35).

Regarding Claim 46, Ilcisin et al. disclose a digital camera message system comprising a message center including apparatus for collecting, preparing and sorting messages to be sent to an integrated assembly containing a transceiver and an independently functional digital camera, the messages including a generic message for transmission to all of a plurality of the assemblies, and interest group based message for transmission to selected assemblies of a particular interest group, a personal message prepared for transmission to a selected one of the assemblies and apparatus for transmission of the messages to the assemblies including apparatus for repeatedly transmitting the messages and apparatus for including a code and each personal message to be received only by a corresponding selected assembly (See Column 3, Lines 2-25; Column 8, Lines 13-35 and note in Figure 1 that the camera 22 clearly functions independently of the transceiver since it is used for taking pictures, not for communicating with the message center).

Ilcisin et al. do not disclose the camera can not communicate with the transceiver. However, Reece et al. disclose that the operator can detach the cellular phone 28 which includes transmitter/receiver 54 from camera 10 (Column 5, lines 43-46). Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Ilcisin et al. by the teaching of Reelee et al. in order to reduce the size of the device when the user does not want to transmit or receive image captured by the camera.

Regarding Claim 47, Ilcisin et al. disclose apparatus for continuously sending the messages (Column 3, Lines 2-12).

Regarding Claim 49, Ilcisin et al. disclose a means for sending the messages only when a request arrives from the transceiver (Column 1, Lines 60-61; Column 2, Lines 49-52).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Luong Nguyen** whose telephone number is (703) 308-9297. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reach on (703) 305-4929.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872 - 9314

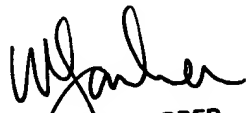
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive,  
Arlington, VA., Sixth Floor (Receptionist).

Application/Control Number: 09/313,131  
Art Unit: 2612

13

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

LN LN  
3/09/02

  
WENDY R. GARBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600